

### REMARKS

Applicants respectfully request reconsideration and withdrawal of the rejections of the claims. To reduce the issues under consideration, claims 1-5 have been canceled.

Claim 11 was rejected under 35 U.S.C. §101, on the grounds that it was directed to non-statutory subject matter. In light of the recent decision of the Board of Patent Appeals and Interferences, *Ex parte Lundgren*, Appeal No. 2003-2088, it is respectfully submitted that the rejection is not supported by the statute. However, to advance the prosecution of the application, claim 11 has been amended to explicitly recite that the computer program product is embodied in a computer-readable medium.

Claims 6-11 were rejected under 35 U.S.C. § 103, on the grounds that they were considered to be unpatentable over the newly-cited Moro patent (US 5,357,348) in view of the Miyake patent (US 6,188,490). Claim 6 is directed to an embodiment of the invention in which the paper on which an image is formed is automatically selected on the basis of the maximum size of multiple document images that are to be printed. In particular, claim 6 recites an image forming apparatus having, among other elements, a receiving unit that receives a print job comprising image data based on multiple document images of various sizes, and a detecting unit for detecting the maximum size of the document images. The claimed image forming apparatus further includes "a selecting unit for selecting paper with a size equal to or larger than the detected maximum size." Thus, the selection of the paper on which to print the multiple document images is carried out the basis of the detected maximum size of those document images.

In rejecting claim 6, the Office Action states that the Moro patent discloses a main control section 61 that judges whether another document can fit on the copying sheet 103,

with reference to column 9, lines 48-54. The Office Action concludes that this disclosure constitutes a detecting unit for detecting the maximum size of document images.

It is respectfully submitted, however, that a person of ordinary skill in the art would not interpret this disclosure to be the same as the claimed subject matter. In particular, the patent does not disclose that the control section 61 detects the *maximum* size of a document image. Rather, the patent only discloses that the control section makes a determination *whether* the next image to be printed can fit within the available space on the sheet 103. This determination is made without considering whether the size of that document is the *maximum* size of all the images to be printed. Nowhere does the Moro patent disclose that the maximum size of an image is taken into account, particularly for the purpose of selecting the size of paper upon which the images are to be printed. Rather, the referenced portion of the patent only discloses that the control section determines whether the *next* document to be printed, regardless of its size, can fit within the available space on the paper sheet.

For at least this reason, therefore, it is respectfully submitted that the Moro patent does not suggest the subject matter of claim 6, whether considered by itself or in combination with the Miyaki patent. Reconsideration and withdrawal of the rejection of claim 6 is therefore respectfully requested.

Claims 7-11 are directed to another embodiment of the invention, in which the magnification of the document images is based upon the maximum size of the document images. For example, claim 7 recites an image forming apparatus having, among other elements, a detecting unit for detecting a maximum size of the document images, and a calculating unit for calculating a scaling factor that causes the detected maximum size to

match the size of a print area. The claimed apparatus also includes a processing unit for scaling the sizes of the document image based upon the calculated scaling factor.

In rejecting claim 7, the Office Action relies upon the Moro patent's above-noted teaching of a main control section that judges whether a document can fit on the copying sheet. As point out above, however, this disclosure does not constitute a teaching of a "detecting unit for detecting a maximum size of document images," as recited in the claim. Specifically, the referenced portion of the disclosure of the Moro patent does not pertain to the *maximum* size of document images. Rather, it is only based upon the size of the *next* document, relative to the available space on the copying sheet.

For reasons similar to those presented above, therefore, it is respectfully submitted that the Moro patent does not suggest the subject matter of claims 7-11, whether considered by itself or in combination with the Miyaki patent. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

In view of the foregoing, it is respectfully submitted that all pending claims are allowable over the prior art of record. Reconsideration and withdrawal of the rejections are therefore respectfully requested.

Respectfully submitted,

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